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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,526	02/13/2002	Ken Shoji	36427-176973	4063

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Washington, DC 20043-9998

EXAMINER
TRAN, SUSAN T

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/049,526	Applicant(s) SHOJI ET AL.	
	Examiner Susan Tran	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6 and 9-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-6, 9-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment and Request for Extension of Time filed 07/17/03.

Claim Objections

Claims 4 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 4 does not further limit the subject mater of claim 1, which is a valerian oil that is fatty-acid-removed. Claim 9 does not further limit the limitations in claim 3. Applicant is required to cancel the claims, or amend the claims to place them in proper dependent form, or rewrite the claims in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 provides for the use of valerian oil, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Warren et al. EP 0 183 436.

Warren teaches a method for reducing physiological and/or stress in human comprising a perfume composition including valerian oil as an active agent suitable for inhalation or transdermal (see abstract, pages 1-2, 10, and 12).

Claims 1, 4, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Shoji et al. JP 10-204473.

Shoji teaches cosmetic products comprising aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid (id).

Claims 1, 4, 5, 10, 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanida et al. JP 01-254628.

Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 5, 10, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al. EP 0 183 436.

Warren is relied upon for the reason stated above. Warren is silent as to the teaching of valerian oil that is valerian fatty-acid-removed. However, it is the position of the examiner that no criticality is seen in the particular limitation, because no unexpected and/or unusual has been shown. Warren obtains the same results desired by the applicant, *e.g.*, using valerian oil in a perfume/cologne composition to reduce stress (abstract and page 2).

Claims 1, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanida et al., in view of Shoji et al.

Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

Tanida is silent as to the teaching of valerian oil that is free from fatty acid as claimed in claims 2 and 8.

Shoji teaches cosmetic products comprising a malodor free aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid (id). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to modify Tanida's inhaling composition using the malodor free valerian oil in view of the teachings of Shoji with the expectation of at least similar result, because the references teach the advantageous results in the use of valerian oil that is free from malodor.

Claims 1, 4, 5, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al., in view of Tanida et al., and Shoji et al.

Warren is relied upon for the reason stated above. Warren is silent as to the teaching of valerian oil that is free from fatty acid as claimed in claims 2 and 8.

Tanida teaches an inhaling composition comprising valerian oil that is free from malodor useful for relieving from a physiological and psychological state (stress), (see abstract).

Tanida is silent as to the teaching of valerian oil that is free from fatty acid.

Shoji teaches cosmetic products comprising a malodor free aroma oil of valerian (see abstract). The valerian root oil is subjected to alkali treatment to remove fatty acid

(id). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to modify Warren's inhaling composition using the inhaling composition in view of the teachings of Tanida and Shoji with the expectation of at least similar result, because the references teach the advantageous results in the use of valerian oil that is free from malodor and useful for inhaling.

Claims 3, 6, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanida et al.

Tanida is relied upon for the reasons stated above. Tanida does not teach the specific amount of valerian oil as claimed. However, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, it is the position of the examiner that it would have been obvious for one of ordinary skill in this art to, by routine experimentation determine a suitable amount of valerian oil to obtain a useful inhalation composition, because Tanida teaches the use of about 0.15% valerian oil in the same composition for the same purpose desired by the applicant, *e.g.*, an inhalation composition for relieving from a physiological and psychological state (stress).

Response to Arguments

Applicant's arguments filed 07/17/03 have been fully considered but they are not persuasive.

Applicant argues that Warren does not teach or suggest valerian oil is a fatty-acid-removed oil. However, applicant has not provided any scientific data showing any unexpected and/or unusual results of the fatty-acid-removed valerian oil over the use of valerian oil taught by Warren. Accordingly, the burden is shifted to applicant to establish that the presence of fatty acid in valerian oil would have a detrimental effect upon the desirability of reducing stress. Applicant's attention is called to page 2, 2nd and 3rd paragraphs, where the prior art teaches that the perfume/cologne composition reduces stress, increase calmness and happiness.

Applicant argues that Warren does not teach that the valerian oil can reduce cortisol concentration in a human body. However, the phrase "reduce cortisol concentration in a human body" is an intended use language. It is noted that intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. Applicant's attention is drawn to Warren at page 2, 2nd paragraph, where Warren teaches decreasing the systolic blood pressure will increase in calmness, happiness, and decrease stress.

Applicant argues that there is nothing in Shoji et al. which teach or suggest that the fatty-acid-removed valerian oil can be used as a stress-relieving agent in a perfume and/or for reducing cortisol concentration in a human body. Contrary to the applicant's argument, the rejected claims are product claims comprising fatty-acid-removed valerian oil. It is noted that products of identical chemical composition cannot have mutually exclusive properties. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Accordingly, it is the position of the examiner that the limitation is inherent since Shoji teaches the use of fatty-acid-removed valerian oil in cosmetic products.

Applicant argues that the stress-relieving agent of the valerian oil taught by Tanida has been denatured due to high heating, and therefore, the fatty-acid-removed valerian oil of Tanida is not capable of reducing cortisol concentration in a human body. Contrary to the applicant's argument, there is no data provided to support applicant's argument. Applicant's attention is called to the teaching of Tanida in the abstract, where Tanida teaches that the composition is useful for relieving a physiological and psychological state caused by excessive excitation of consciousness level, *e.g.* irritation, anxiety or tension. Accordingly, the valerian oil in the composition taught by Tanida is useful to reduce stress as desired by the applicant.

Applicant argues that there's no motivation/suggestion/teaching to combine the references under the 103(a) rejections. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is further noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
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